

Amendment under 37 C.F.R. § 1.116
U.S. Application No. 09/805,185

REMARKS

Claims 1-11 have been examined. Claims 1-5 and 7 have been rejected under 35 U.S.C. § 103(a). Also, the Examiner has indicated that claims 6 and 8-11 are allowed.

Rejections under 35 U.S.C. § 103(a)

A. The Examiner has rejected claims 1-3, 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art ("AAPA") in view of U.S. Patent No. 6,422,139 to DeCruz ("DeCruz").

1. Claim 1

The Examiner has maintained the previous rejection of claims 1-3, 5 and 7 in view of the AAPA and DeCruz. In response to Applicant's arguments presented in the October 15, 2003 Amendment, the Examiner notes that DeCruz, "was not relied upon for the teaching of setting up a separate preregistration unit for pre-registering the sheets. DeCruz was relied upon for the teaching of using a light box having a light transmission member operable to allow transmission of light from a lower side,..." (pgs. 3-4 of Office Action). Applicant submits that the Examiner's statements indicate that the Examiner is selectively choosing individual components from the applied references to arrive at the claimed invention without regard for the teachings of the references as a whole. For example, the Federal Circuit has clearly stated that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to a

Amendment under 37 C.F.R. § 1.116
U.S. Application No. 09/805,185

full appreciation of what such reference fairly suggests to one skilled in the art.” Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986), citing In re Wesslau, 353 F.2d 238, 241 (CCPA 1965), cert. denied, 484 U.S. 823 (1987).

As noted in the October 15, 2003 Amendment, the pre-registration unit 2A of DeCruz is separate from the printing apparatus 4A (Figs. 1 and 18). DeCruz discloses that the use of a separate pre-registration unit simplifies and speeds up the printing process, by eliminating downtime associated with registering screens at the press (col. 10, lines 32-40). Accordingly, when the DeCruz reference is considered as a whole, it **teaches away** from providing the plexiglass 7L, 2L and lamps 34L at either the cassette 1A or the printing station 12 of the printing apparatus 4A (i.e., since such configuration would appear to slow down the printing process). Therefore, the reference does not “fairly suggest to one skilled in the art” to put the plexiglass 7L, 2L and lamps 34L at a conveyor portion. Thus, Applicant submits that there is no motivation to combine the references in the manner maintained by the Examiner, and further, that the Examiner’s assertions appear to indicate the use of impermissible hindsight reasoning.

Accordingly, Applicant submits that claim 1 is patentable over the cited references and respectfully requests the Examiner to reconsider and withdraw the rejection.

2. Claims 2, 3, 5 and 7

Since claims 2, 3, 5 and 7 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

Amendment under 37 C.F.R. § 1.116
U.S. Application No. 09/805,185

B. The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the AAPA in view of DeCruz and JP 11-106685 to Ishikawa ("Ishikawa").

The Examiner has maintained the previous rejection of claim 4 in view of the AAPA, DeCruz and Ishikawa. On page 4 of the Office Action, the Examiner maintains that the application of the luminous coating disclosed in Ishikawa would improve brightness so as to further facilitate the registration process.

Applicant respectfully traverses the rejection for the following reasons. First, as set forth above, it would not have been obvious to combine at least the APA and DeCruz. Therefore, Applicant submits that claim 4 is patentable at least by virtue of its dependency from claim 1.

Secondly, DeCruz does not disclose the use of a light accumulation fluorescent substance, and further, Ishikawa merely discloses a luminous coating material in the display. Ishikawa relates to a phosphorescent paint which is aimed at improving brightness by preventing sedimentation of phosphorescent materials and to a display object that uses this paint, such as a dial of a clock. That is, Ishikawa does not suggest, or even mention, a light accumulation fluorescent substance that is coated on a light transmission member, or for that matter, that is used in place of a light transmission member for illuminating sheets from below. Thus, Ishikawa fails to cure the deficient teachings of the AAPA and DeCruz.

Accordingly, Applicant submits that claim 4 is patentable over the cited references, and respectfully requests the Examiner to reconsider and withdraw the rejection.

Amendment under 37 C.F.R. § 1.116
U.S. Application No. 09/805,185

Allowable Subject Matter

As noted previously, the Examiner has indicated that claims 6 and 8-11 are allowed.

Newly Added Claims

Applicant has added new claims 12-17 to provide more varied protection for the present invention.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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